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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/788,863 | 02/27/2004 | Joseph H. Sassine | I69.12-0600 | 7195 |
| 164 | 7590 | 10/16/2008 | EXAMINER | |
| KINNEY & LANGE, P.A. THE KINNEY & LANGE BUILDING 312 SOUTH THIRD STREET MINNEAPOLIS, MN 55415-1002 | | | WATKO, JULIE ANNE | |
| ART UNIT | PAPER NUMBER | | | |
| | | 2627 | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|--------------------------------------|---------------------------------------|
| Office Action Summary | Application No. 10/788,863 | Applicant(s) SASSINE ET AL. |
| | Examiner Julie Anne Watko | Art Unit 2627 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 September 2008.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-16,18-20 and 26-32 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 16,18-20 and 27-31 is/are allowed.
 6) Claim(s) 1-3,5-12,26 and 32 is/are rejected.
 7) Claim(s) 13-15 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 27 February 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No./Mail Date _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-548) | |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No./Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 5-12, 26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arya et al (US Pat. No. 6785094 B2) in view of Sutton et al (US Pat. No. 5965249).

See statement of rejection in the non-final office action mailed 05/30/2008.

Allowable Subject Matter

3. Claims 13-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 16, 18-20, and 27-31 are allowed.

Response to Arguments

5. Applicant's arguments filed 09/02/2008 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "balancing") are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that, although some teaching, suggestion, or motivation (TSM) found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art is one way for an Examiner to establish a rationale for obviousness, no specific teaching, suggestion, nor motivation to combine (TSM) is required to establish a *prima facie* case of obviousness under 35 USC 103. See *Ex parte Smith*, 83 USPQ2d 1509 (BPAI 2007), citing *KSR International Co. v. Teleflex Inc.*, 127 SCt 1727, 82 USPQ 2d 1385 (2007). See also Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., 72 Fed. Reg. 57526, 57529 (October 10, 2007) (including a non-exclusive list of seven options for a Patent Examiner to establish a rationale for obviousness).

In this case, Sutton et al provides motivation for improving dynamic loss moduli and achieving sufficient damping capacity in disk drive suspensions. It is noted by the Examiner that the device of Arya et al is a disk drive suspension; thus, the teachings of Sutton et al are applicable to the device of Arya et al.

On page 2, 2nd paragraph, Applicant argues "Arya et al. contain no teaching ... that would lead one of ordinary skill in the art to the teachings of Sutton et al." The Examiner has considered this argument thoroughly and asserts that there is no requirement that the Arya et al reference say anything to "lead one of ordinary skill in the art to the teachings of Sutton et al." "Inventors and other skilled workers in a particular field are conclusively presumed to have

constructive knowledge of all references which are available to the public in printed form at the time of making an invention." *Brenner et al. v. Ladd*, 147 USPQ 87, 89 (D.D.C. 1965).

Furthermore, Arya et al is not the only resource available for the Examiner to find the rationale for obviousness. The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning). It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (motivation question arises in the context of the general problem confronting the inventor rather than the specific problem solved by the invention); *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1323, 76 USPQ2d 1662, 1685 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); *In re Linter*, 458 F.2d 1013, 173 USPQ 560

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(CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). Moreover, “the obviousness analysis cannot be confined by . . . overemphasis on the importance of published articles and the explicit content of issued patents. . . . In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends.” *KSR*, 82 USPQ2d at 1396. In this case, the Sutton et al reference is a source for the obviousness rationale.

On page 3, 1st paragraph, Applicant argues that “the only references to damping by Arya et al are in passing and ancillary to the method of manufacture disclosed”. The Examiner has considered this argument thoroughly and asserts “It is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art.” *In re Fritch*, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992). Thus, whether a prior art reference’s teaching is ancillary is not germane to the obviousness of the rejected claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on Mon & Fri, 9:30AM to 7:30PM, Tues-Thurs after 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Julie Anne Watko/
Primary Examiner, Art Unit 2627

October 6, 2008
JAW